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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/994,492 | 11/26/2001 | Dana C. Mears | ZM0 442 | 1101 |
| 43963 | 7590 | 11/19/2004 | EXAMINER | |
| ZIMMER TECHNOLOGY - BAKER & DANIELS | | | PHILOGENE, PEDRO | |
| 111 EAST WAYNE STREET, SUITE 800 | | | ART UNIT | |
| FORT WAYNE, IN 46802 | | | PAPER NUMBER | |

3732

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/994,492 | Applicant(s) MEARS, DANA C. | |
| | Examiner Pedro Philogene | Art Unit 3732 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-14,16-18,21-23,25-27,30-35 and 43-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-14,16-18,21-23,25-27,30-35 and 43-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6,8-14,16-18,21-23,25-27,30-35, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stryker (3,221,744) in view of Rubin (3,716,057).

With respect to claims 1, 4, 8, 10, 14, 16, 21,25,30 Stryker discloses a handle (11) a cutter (10) with spacer means (17,18) having a spacer means thickness and head (12) having a head thickness and recess blade (14) a curvature (13).

It is noted that Stryker did not teach of a spacer means thickness greater than the head thickness, as claimed by applicant. However, in a similar art, Rubin evidences the use of a chisel for cutting bony tissue with a head (12) having a thickness and a spacer (16) having a thickness greater than the thickness of the head to guard against slippage of the cutting end.

Therefore, given the teaching of Rubin, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Stryker, as taught by Rubin, to guard against slippage of the cutting end.

As to the language, whereby said head can be positioned intermediate a ball and socket of a ball-and-socket joint; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the

prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to claims 2,3,5,11, 13,17,22, 26, 31-35, the above combination of references discloses all the limitations as set forth and as best seen in the figures.

With respect to the claims 3,6,9,12,18,23,27, it is noted that the above combination of references did not teach of joint spacer having a thickness of about 31 millimeters; and, an extension extending 30 degrees away from the radius of curvature; as claimed by applicant. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to reach an optimum value since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272,205 USPQ 215 (CCPA 1980). It also has been held that where the general condition of a claim is disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stryker (3,221,744) in view of McGuire (5,391,169).

With respect to claims 43-47, it is noted that Stryker teach all the limitations, except for spacer means offset from the head; as claimed by applicant. However, in a

similar art, McGuire evidences the use of an offset patellar tendon harvester to control the harvester from outside the incision.

Therefore, given the teaching of McGuire, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Stryker, as taught by McGuire to have a device that can be manipulated from outside the incision.

Response to Arguments

Applicant's arguments filed 6/17/04 have been fully considered but they are not persuasive. With respect to applicant's arguments that the curved neck is curved such that it can be positioned intermediate a ball and socket of a ball-and-socket joint; it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
November 15, 2004


PEDRO PHILOGENE
PRIMARY EXAMINER